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EXAMINER

WALLERSON, MARK E

| ART UNIT | PAPER NUMBER |
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2626

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/800,713

Applicant(s)

ABRAM ET AL.

Examiner

Mark E. Wallerson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 27 May 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 10-35,47 and 48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 10-35,47 and 48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Part III DETAILED ACTION

Notice to Applicant(s)

1. This action is responsive to the following communications: amendment filed on 5/27/04.

2. This application has been reconsidered. Claims 10-35, 47 and 48 are pending.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 17-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claims 17 and 21, the phrase "each page of the coloring book" is unclear. Maybe Applicant meant "each **page**".

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 17-35, 47 and 48 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which

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was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no disclosure in the original specification for "each page of the coloring book is printed on a single surface" or "the storyboard is printed on a single surface". If Applicant believes that rejection to be in error, Applicant is requested to provide SPECIFIC support for this subject matter in the original specification.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 10, 13, 14, 15, 16, 17, 18, 19, 20, 34, 35, and 48 are rejected under 35 U.S.C.

103(a) as being unpatentable over Spector (U. S. 6,356,274) in view of Manico (U. S. 6,373,551) and Chee (U. S. 6,099,928).

With respect to claims 10, 15, 17, 34, 35, and 48, Spector discloses a method comprising rendering a line-art image from a digital image (which reads on converting a colored picture into a line drawing) (the abstract, lines 1-3); formatting a coloring book (the printed sheets) image rendered from the line-art image (column 2, lines 44-52), and printing the image (column 2, lines 44-52), wherein the coloring book image represents the digital image (column 2, lines 11-17) and includes at least one fillable area (color-in zones) (column 4, lines 45-51).

Spector differs from claims 10, 17, 34, 35, and 48, in that he does not clearly disclose receiving the digital image at a server and transmitting the coloring book image to a client.

Manico discloses a method for processing digital film using a coloring book algorithm (column 4, lines 45-62) wherein a digital image is received at a server (450) and transmitted to a client (column 5, lines 43-52). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Spector to receive the digital image at a server and transmit the coloring book image to a client. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Spector by the teaching of Manico in order allow the customer to easily obtain the image.

Spector as modified also differs from claims 10, 17, 34, 35, and 48 in that he does not clearly disclose including the coloring book image with a story board and attaching plural images to form a coloring book.

Chee discloses a method for forming coloring books (column 3, lines 19-23) wherein plural images are attached (hinged) to form a book (column 3, lines 15-35) and automatically including the coloring book image within a story board (figure 4 and column 7, lines 40-57), wherein the story book is printed on a single surface (column 7, lines 47-57). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Spector as modified to include the coloring book image with a story board and attach plural images to form a coloring book. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Spector as modified by the teaching of Chee in order to obtain a greater range of images.

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With respect to claims 13, 14, 18, and 19, Spector differs from claims 13, 14, 18, and 19 in that he does not clearly disclose the printing is performed at a public kiosk.

Manico discloses a method for communication of digital images generated from film utilizing a kiosk (520) to generate and print the images (column 5, lines 43-52). Manico also discloses that a fee is charged for printing at the kiosk (column 4, lines 37-45). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Spector whereby the printing is performed at a public kiosk. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Spector by the teaching of Manico in order to give the customer easier public access to produce the coloring sheets.

With respect to claims 16 and 20, Spector discloses the digital image covers the full range of colors (column 3, lines 50-66).

9. Claims 11 and 12, are rejected under 35 U.S.C. 103(a) as being unpatentable over Spector in view of Manico and Chee as applied to claim 10 above, and further in view of Schipper (EP 0713788).

With respect to claims 11 and 12, Spector as modified differs from claims 11 and 12, in that he does not clearly disclose generating a color sample, assigning an image area to the sample and printing an index name and number with the sample. Schipper discloses dividing an image formed on an electronic camera into contoured fields or regions. The fields are given an identifier and the image is printed out, thereby enabling automatic generation of painting by numbers originals. Therefore, it would have been obvious to one of ordinary skill in the art at

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the time of the invention to have modified Spector as modified in order to assist the user in coloring the images.

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 21, 22, 26, 31, 32, 33, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spector in view of Chee.

With respect to claims 21, 22, 26, 31, 33, and 47, Spector discloses a method comprising rendering a line-art image from a digital image (which reads on converting a colored picture into a line drawing) (the abstract, lines 1-3); formatting a coloring book (the printed sheets) image rendered from the line-art image (column 2, lines 44-52), transmitting the coloring book to the client (which reads on displaying or printing the image) (figure 4), and printing the image (column 2, lines 44-52), wherein each page of the coloring book is printed on a single surface (a paper sheet) (figures 2 and 3 and column 2, lines 44-52), wherein the coloring book image represents the digital image (column 2, lines 11-17) and includes at least one fillable area (color-in zones) (column 4, lines 45-51).

Spector differs from claims 21, 33 and 47 in that he does not clearly disclose attaching plural images to form a coloring book.

Chee discloses a method for forming coloring books (column 3, lines 19-23) wherein plural images are attached (hinged) to form a book (column 3, lines 15-35). Therefore, it would

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have been obvious to one of ordinary skill in the art at the time of the invention to have modified Spector as modified to attach plural images to form a coloring book. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Spector as modified by the teaching of Chee in order to obtain a more compact book.

With respect to claim 32, Spector discloses the digital image covers the full range of colors (column 3, lines 50-66).

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spector in view of Chee as applied to claim 21 above, and further in view of Schipper (EP 0713788).

With respect to claims 23-25, Spector as modified differs from claims 23-25, in that he does not clearly disclose generating a color sample, assigning an image area to the sample and printing an index name and number with the sample. Schipper discloses dividing an image formed on an electronic camera into contoured fields or regions. The fields are given an identifier and the image is printed out, thereby enabling automatic generation of painting by numbers originals. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Spector as modified in order to assist the user in coloring the images.

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14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spector in view of Chee as applied to claims 21 and 26 above, and further in view of Manico.

With respect to claims 27, 28, 29, 30, Spector as modified differs from claims 27, 28, 29, 30 in that he does not clearly disclose the printing is performed at a public kiosk.

Manico discloses a method for communication of digital images generated from film utilizing a kiosk (520) to generate and print the images (column 5, lines 43-52). Manico also discloses that a fee is charged for printing at the kiosk (column 4, lines 37-45). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Spector as modified whereby the printing is performed at a public kiosk. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Spector as modified by the teaching of Manico in order to give the customer easier public access to produce the coloring sheets.

Response to Arguments

16. Applicant's arguments filed 4/12/04 have been fully considered but they are not persuasive. Applicant submits that Chee fails to disclose a storybook containing plural images. The Examiner disagrees. Chee discloses being able to print out six original prints on a sheet (figure 4 and column 7, lines 40-57). Applicant also submits that the cited references do not

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disclose printing each page on a single surface. In addition to the comments in paragraph 6 above, Spector discloses each page of the coloring book is printed on a single surface (a paper sheet) (figures 2 and 3 and column 2, lines 44-52).

Conclusion

17. All claims are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark E. Wallerson whose telephone number is (703) 305-8581. The examiner can normally be reached on Monday-Friday - 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (703) 305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mark E. Wallerson
Primary Examiner

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MARK WALLERSON
PRIMARY EXAMINER